

U.S. Application No. 09/911,911
Reply to Office Action dated January 12, 2006

PATENT
450100-0358

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejection of the application are respectfully requested in view of the remarks herein, which place the application into condition for allowance.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-19 and 21-22 are currently pending. Claims 1, 3-5, 10, 13, 16, and 21-22 are independent. No new matter has been introduced.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-4 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Application Publication No. 2002/0046407 to Franco (hereinafter, merely "Franco") in view of U.S. Patent Application Publication No. 2001/0029610 to Corvin et al. (hereinafter, merely "Corvin") and further in view of U.S. Patent Application Publication No. 2004/0168188 to Bennington et al. (hereinafter, merely "Bennington").

Claims 5-15 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Franco in view of Corvin and further in view of U.S. Patent No. 6,704,929 to Ozer et al. (hereinafter, merely "Ozer").

Claims 16-22 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Franco in view of Corvin.

As understood by Applicants, Franco relates to a remotely programmable broadcast content recording system that is programmed through a web page to record broadcast content such as television programs.

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As understood by Applicants, Corvin relates to systems and methods for providing promotions with recorded programs. These systems and methods provide for selecting a program to record, selecting a promotion, recording the selected program; and recording the promotion with the program or inserting the promotion during playback of the recorded program.

As understood by Applicants, Ozer relates to systems and methods for providing and tracking viewing behavior of home entertainment systems.

As understood by Applicants, Bennington relates to an electronic program schedule system which includes a receiver for receiving broadcast, satellite or cablecast television programs for a plurality of television channels and a tuner for tuning a television receiver to a selected one of the plurality of channels. A data processor receives and stores in a memory television program schedule information for a plurality of television programs to appear on the plurality of television channels. A user control apparatus, such as a remote controller, is utilized by a viewer to choose user control commands and transmit signals in response to the data processor which receives the signals in response to user control commands. A television receiver is used to display the television programs and television program schedule information. A video display generator receives video control commands from the data processor and program schedule information from the memory and displays a portion of the program schedule information in overlaying relationship with a television program appearing on a television channel in at least one mode of operation of the television programming guide. The data processor controls the video display generator with video control commands, issued in response to the user control commands, to display program schedule information for any chosen one of the plurality of television programs in overlaying relationship with at least one television program then appearing on any chosen one of the plurality of channels on the television receiver.

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A. INDEPENDENT CLAIMS 1, 3, AND 4

Claim 1 recites, *inter alia*:

“... display control means for controlling the displaying of said advertisement-associated data received by said receiving means to display said advertisement-associated data and said television program substantially at same time for a viewer to view said advertisement-associated data while simultaneously viewing said television program.” (Emphasis added)

Applicants respectfully submit that (1) the combination of Franco, Corvin, and Bennington does not teach the above-recited feature of claim 1; (2) that the applied combination teaches away from the claimed invention; and (3) that the applied combination is improper because it lacks motivation and relies on impermissible hindsight.

The cited portions of Franco, Corvin, and Bennington do not disclose or suggest displaying the advertisement-associated data and the television program substantially at same time for a viewer to view the advertisement-associated data while simultaneously viewing the television program, as recited in claim 1. The Office Action concedes on page 10 that the combination of Franco and Corvin “fails to disclose displaying said advertisement-associated data and said television program substantially at same time for a viewer to view said advertisement associated data while simultaneously viewing said television program.” The Office Action relies on Paragraph 0097 of Bennington for a teaching of the missing feature. Unfortunately, Applicants respectfully submit that Paragraph 0097 of Bennington fails to teach the recited feature of claim 1. Paragraph 0097, and Bennington in general, deal with displaying program schedule information simultaneously with a television program. There is no suggestion or motivation to display advertisement information simultaneously with a television program.

Furthermore, Applicants respectfully submit that MPEP §2141.02 (VI) states that

“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the

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claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*,
721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469
U.S. 851 (1984).” (Emphasis added)

Indeed, as stated previously, Applicants respectfully submit that both Franco and Corvin teach away from displaying the advertisement-associated data and the television program at the same time, so that a user views simultaneously the advertisement-associated data and the television program. Franco teaches on page 12, paragraph [0133], that “viewers can avoid watching commercials that are not of interest,” which clearly teaches away from a viewer viewing the advertisement-associated data while simultaneously viewing the television program, as recited in claim 1. Corvin teaches on page 3, paragraph [0032], that:

“the insertion of a selected promotion during playback of the recorded program may cause the processor to send, for example, a pause or stop command or signal to halt the playback of the recorded program. After, the promotion is inserted and played, the processor may then send a command or signal to continue the playback of the remaining portion or portions of the recorded program.” (Emphasis added)

Thus, Corvin clearly teaches away from displaying the advertisement-associated data and the television program at the same time, as recited in claim 1.

Finally, Applicants respectfully submit that MPEP §2143.01(III) states that

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)” (Emphasis added)

Applicants respectfully submit that the Office Action has failed to provide a suggestion or motivation to combine the teachings of Franco and Corvin, and to further modify that combination as allegedly suggested by Bennington. The closest disclosure of a motivation appears on page 11 of the Office Action: “so as to maximize the viewer’s exposure to an advertisement.” However, this motivation is found nowhere in the prior art of record, and

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appears to have been created out of thin air. Indeed, Applicants respectfully submit there is no motivation anywhere in the art of record to suggest the applied combination. Since there is no motivation in the references themselves, the Office Action has relied on impermissible hindsight to create a mosaic of features from the prior art in a futile attempt to create a vague resemblance of Applicants' claimed invention.

Therefore, for all the reasons stated above, Applicants respectfully submit that claim 1 is patentable.

For reasons similar to those described above with regard to independent claim 1 independent claims 3 and 4 are also patentable.

B. INDEPENDENT CLAIMS 5, 10, AND 13

Claim 5 recites, *inter alia*:

"... display control means for controlling the displaying of said advertisement-associated data received by said first receiving means to display said advertisement-associated data for a viewer to view said advertisement-associated data before receiving said preset- recording data by said second receiving means,

wherein said viewer cannot view said television program unless said advertisement-associated data first has been displayed."
(Emphasis added)

Applicants respectfully submit that (1) the combination of Franco, Corvin, and Ozer does not teach the above-recited feature of claim 5; (2) that the applied combination teaches away from the claimed invention; and (3) that the applied combination is improper because it lacks motivation and relies on impermissible hindsight.

Applicants respectfully submit that the combination of Franco, Corvin, and Ozer does not disclose or suggest, displaying the advertisement-associated data for a viewer to view the advertisement-associated data before receiving said preset- recording data by the second

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receiving means, so that the viewer cannot view the television program unless the viewer has viewed the advertisement-associated data, as recited in claim 5.

Furthermore, as explained in detail above in response to the rejection of claim 1, both Franco and Corvin teach away from the feature recited in claim 5. Franco discloses that viewers can avoid watching commercials, and thus teaches away from the viewer having to view the advertisement before being able to view the television program. Corvin discloses that the promotion is inserted somewhere into the program, but does not prevent a viewer from skipping the commercial, the feature recited in claim 5.

Finally, Applicants respectfully submit that the Office Action has failed to provide a suggestion or motivation to combine the teachings of Franco and Corvin, and to further modify that combination as allegedly suggested by Ozer. Applicants respectfully submit there is no motivation anywhere in the art of record to suggest the applied combination. Since there is no motivation in the references themselves, the Office Action has relied on impermissible hindsight to create a mosaic of features from the prior art in a futile attempt to create a vague resemblance of Applicants' claimed invention.

Therefore, for all the reasons stated above, Applicants respectfully submit that claim 5 is patentable.

For reasons similar to those described above with regard to independent claim 5, independent claims 10 and 13 are also believed to be patentable.

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C. INDEPENDENT CLAIMS 16, 21, AND 22

Claim 16 recites, *inter alia*:

“... first transmitting means for transmitting said advertisement-associated data acquired by said acquiring means to said information processing apparatus; and

second transmitting means for transmitting said preset-recording data generated by said generating means to said information processing apparatus after said advertisement-associated data has been displayed on said information processing apparatus.”
(Emphasis added)

Applicants respectfully submit that (1) the combination of Franco and Corvin does not teach the above-recited feature of claim 16; (2) that the applied combination teaches away from the claimed invention; and (3) that the applied combination is improper because it lacks motivation and relies on impermissible hindsight.

Applicants respectfully submit that the combination of Franco and Corvin does not disclose or suggest, transmitting the preset-recording data to the information processing apparatus after the advertisement-associated data has been displayed on the information processing apparatus, as recited in claim 16.

Furthermore, as explained in detail above in response to the rejection of claim 1, both Franco and Corvin teach away from the feature recited in claim 16. Franco discloses that viewers can avoid watching commercials, and thus teaches away from the viewer having to view the advertisement before being able to view the television program. Corvin discloses that the promotion is inserted somewhere into the program, but does not prevent a viewer from skipping the commercial, the feature recited in claim 16.

Finally, Applicants respectfully submit that the Office Action has failed to provide a suggestion or motivation to combine the teachings of Franco and Corvin. The closest disclosure of a motivation appears on page 6 of the Office Action: “If the processor inserts the

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promotion in the beginning of a television program, the user cannot view the television program until after the promotion has been displayed.” However, this motivation is found nowhere in the prior art of record, and appears to have been created out of thin air. Indeed, Applicants respectfully submit there is no motivation anywhere in the art of record to suggest the applied combination. Since there is no motivation in the references themselves, the Office Action has relied on impermissible hindsight to create a mosaic of features from the prior art in a futile attempt to create a vague resemblance of Applicants’ claimed invention.

Therefore, for all the reasons stated above, Applicants respectfully submit that claim 16 is patentable.

For reasons similar to those described above with regard to independent claim 16, independent claims 21 and 22 are also believed to be patentable.

III. DEPENDENT CLAIMS

The other claims are each dependent from one of the independent claims discussed above, and are therefore patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

The Office Action relied on Official Notice in order to reject claims 18-19 on page 6 and claims 6-7, 11-12, and 14-15 on page 16. Applicants respectfully traverse the Official Notice. There is no reference or teaching, much less a motivation to combine, the use of correlation information (such as keyword information or the like).

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CONCLUSION

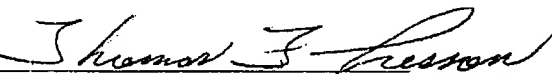
All claims are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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